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REMARKS:

The comments of the Examiner as set forth in the Office Paper mailed 5 October, 2005 have been carefully studied and reviewed.

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Claims 1-33 are pending in the application.

Claims 1-15, and 27-33 have been withdrawn from consideration.

Claims 16-26 have been rejected.

10

Election/Restriction

Applicants hereby affirm the provisional election to prosecute the claims of **group II** (Claims 9-26, drawn to a method for manufacturing a skateboard deck), **Species B** (Claims 16-26), drawn to the graphite cloth layers already having the resin therein as disclosed on p. 11, line 13 - p. 13, line 34.

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Information Disclosure Statement

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An Information Disclosure Statement by Applicants is submitted herewith as a separate paper.

Claim Rejections: 35 U.S.C. §103

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Claims 16-23, and 25-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Renard (US 2002/0064640) in view of Valteau et al. (U.S. Pat. No. 5,028,100).

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0 The basis of this rejection is that while Renard
teaches making a skateboard deck, it is silent as to the
cloth being graphite cloth, and it is known in the art to
make a skateboard deck from resin-impregnated cloth layers,
as alleged to be taught by Valleau et al.

5 Therefore, it would have been obvious to the skilled
artisan to use graphite fibers for the cloth layers of
Renard because such is known in the skateboard deck art, as
taught by Valleau et al., where such a material offers
10 superior strength, stiffness, dimensional stability
toughness, low weight and low cost-especially in light of
the fact that Renard teaches the fibers can be carbon and/or
metal fibers and graphite is derived from carbon and
exhibits metallic properties.

15 Applicant respectfully traverses these rejections. To
reject a claimed invention based upon its obviousness over
the prior art, the examiner must support such a rejection by
establishing the invention's prima facie obviousness. The
20 examiner must show where in the art cited there is a
description of the claimed invention sufficient to have
taught or suggested the invention to ordinarily skilled
artisans of the time (see, e.g., ACS Hospital Systems, Inc.,
v. Montefiore Hospital, 221 USPQ 929, 933 (F. Cir. 1984);
25 see also, In re Fine, 5 USPQ2d 1596 (F. Cir. 1988)).

Evaluation of whether the cited documents provide the
necessary description requires consideration of "(1) whether
the prior art would have suggested to those of ordinary

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0 skill in the art they should make the claimed [invention]
... and (2) whether the prior art would have also revealed
that in so making ... those of ordinary skill would have a
reasonable expectation of success" (In re Vaeck, 20 USPQ2d
1438, 1442 (F.Cir. 1991)). "Both the suggestion and the
5 reasonable expectation of success must be found in the prior
art, not in the applicant's disclosure" (In re Vaeck,
supra). That is, "one cannot use hindsight reconstruction
to pick and choose amongst isolated disclosures in the prior
art to deprecate the claimed invention" (In re Fine, supra
10 at 1600).

But there is no teaching in either reference to
manufacture a skateboard deck from graphite cloth that has
its maximum deflection between the regions of the skateboard
15 deck where the trucks will be attached to the deck. The
claimed process of making a skateboard deck produces a
skateboard that has properties (see paragraph below) that
are not described in the cited references.

20 Claims 16 has been amended to describe the claimed
invention in greater detail. As Applicants have described
in the specification, the number of layers to be used in the
skateboard deck is determined based on a combination of the
weight of the rider, and the conditions under which the
25 skateboard deck will later be used, not merely some randomly
chosen mathematical function. Applicants' process produces
a skateboard deck that is not like skateboard decks prepared
using processes of the prior art; the skateboard deck
produced using the claimed process has its' maximum

0 deflection at a point that is halfway between where the
skateboard trucks will be attached. Thus, when the
skateboard is used, the deflection of the deck consequently
produces a greater downward force when the skateboard is
used for cornering, enabling the rider of the skateboard to
5 have greater control over the skateboard than could be
achieved with skateboard decks manufactured using prior art
processes.

Thus, with no such teaching in the prior art, nor in
10 the references cited by the Examiner, there can be no prima
facie case of obviousness, and the rejection of Claim 16
under 35 U.S.C. §103(a) must, respectfully, be withdrawn.

The basis for this amendment is Claims 25 and 26 as
15 originally filed, and the specification from page 15, line 1
through p. 17, line 3, and particularly at p. 15, lines 1-
33, and p. 16, line 28 - p. 17, line 3. Claims 25 and 26
have been cancelled to avoid duplication of claims.

20 **Claims 17-23**

Claims 17-23 were rejected under 35 U.S.C. §103(a)
because it is alleged that the selection of process
parameters such as heating temperature, etc. would have been
within the purview of the skilled artisan.

25 Applicants respectfully traverse this rejection,
because having distinguished the independent claim, Claim 16
over the prior art, Applicants respectfully submit that
these dependent Claims similarly define patentable subject

0 matter, and accordingly, the rejection of Claims 17-23 under
35 U.S.C. §103(a) must therefore be withdrawn.

Claims 25 and 26

Claims 25 and 26 have also been rejected under 35
5 U.S.C. §103(a).

Claims 25 and 26 have been cancelled to avoid being
duplicate claims and to facilitate the prosecution of this
application. The language of original Claims 25 and 26 has
10 been included in amended Claim 16, as described previously.

Claim 24

Claim 24 was rejected under 35 U.S.C. §103(a) as being
unpatentable over Renard et al. and Valteau et al. as
15 applied to claim 17 above, and further in view of Moore
(U.S. Pat. No. 4,295,656).

The Examiner alleges that Renard is silent as to an
additional layer comprising fiberglass and the resin being
20 used for the deck bottom, but that it is known in the
skateboard deck art to mold a plurality of layers to form a
skateboard deck "core" and then apply resin-impregnated
fiberglass layers to the top and bottom of the "core" to
achieve tapered wing sections that retain lateral
25 flexibility for turn radius control, as taught by Moore
(abstract; col. 4, lines 10-12, 16-18, 27-31 and 44-55).

Applicant respectfully traverses this rejection.
Claim 24 does not discuss wing sections that retain lateral

0 flexibility for turn radius control; this is a property
mentioned in the Moore reference. The Moore reference
emphasizes that the degree of flexibility is dependent upon
a combination of the thickness of the planks in the deck
core, and the number of layers of the fiberglass cloth in
5 combination with impregnation of a particular resin which
may be more or less flexible when cured (col. 4, lines 32-
37). As shown in the cross-sectional views of Moore's Figs.
4 and 7, the wings extend over a deck and obviously contain
several layers of fiberglass. In view of Moore's teaching
10 that it is the combination of the layers of material that
provide the flexibility to the deck and the wings, there is
no suggestion in the reference to use only a single layer of
material beneath the deck. There is no teaching in the
reference to suggest that use of a single layer of material
15 would provide the properties sought, this is based on
impermissible speculation by the Examiner. Therefore, the
rejection of Claim 24 under 35 U.S.C. §103(a) must
respectfully, be reversed.

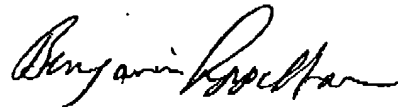
20 Conclusion

Thus, the present pending Claims distinguish over the
prior art and define patentable subject matter.

25 Applicant thanks the Examiner for her thoughtful review
of this application, and respectfully requests the Examiner
review the pending Claims and to find that they define
patentable subject matter. Thus, it is respectfully
requested that the present pending Claims be allowed.

0 In the event that this Amendment does not place the
application in condition for allowance, the Examiner is
respectfully requested to telephone the undersigned in order
that an attempt can be made to place the application in
condition for allowance as expeditiously as possible.
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Respectfully submitted,



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